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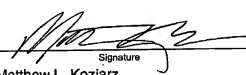
DEC 10 2007

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 67097-022; 11083	
CERTIFICATE OF FACSIMILE I hereby certify that this Pre-Appeal Brief Request For Review and Notice of Appeal are being facsimile transmitted to (571) 273-8300. on <u>December 10, 2007</u> Signature <u><i>Laura Combs</i></u> Typed or printed name <u>Laura Combs</u>		Application Number 10/770893	Filed 2004-02-03
		First Named Inventor Song	
		Art Unit 1742	Examiner Morillo, Janel Combs
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>53,154</u>		 Signature Matthew L. Koziarz Typed or printed name 248 988 8360 Telephone number December 10, 2007 Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Laura Combs

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Serial No. 10/770,893
67097-022**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Song
Serial No.: 10/770,893
Filed: February 3, 2004
Group Art Unit: 1742
Examiner: Morillo, Janell Combs
Title: CASTABLE HIGH TEMPERATURE ALUMINUM ALLOY
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In response to the final office action mailed on August 8, 2007, Applicant respectfully submits a Pre-Appeal Brief Request for Review. This request is filed with a Notice of Appeal. As will be explained in further detail, the Review is requested for the reasons set forth below.

- I. Claims 1-4, 10-13, and 26-29 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Watson.
- II. Claims 1-5, 7, 8, 10-16, and 27-29 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Higashi.
- III. Claims 1-3, 7-12, 15, 16, 26, and 27 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over EP 750911.
- IV. Claims 1-6, 10-14, 26-29 were improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Olson.

Arguments

- I. Rejection of claims 1-4, 10-13 and 26-29 under 103(a).

In support of the rejection, the Examiner argues that Watson teaches that the elements Ti, Zr, Sc, Er, and Yb are L12 formers that can be substituted for one another and that it would have

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been obvious to replace Sc with Er and Yb. Respectfully, Applicant disagrees with this reasoning because Watson does not teach that all of the listed elements are equivalents that may be substituted for one another. That is, the broad composition that the Examiner relies on (col. 2, lines 10-11) and also the more specific examples given in Watson (col. 4, lines 5-23) each include the element Sc. Therefore, Watson appears to implicitly teach that Sc is irreplaceable. Furthermore, none of the given compositions of Watson disclose using a combination of Er and Yb. Therefore, through the example compositions, Watson does not teach that Er and Yb may be substituted for Sc as the Examiner suggests. For this reason, Appellant respectfully requests that the rejection be withdrawn.

II. Rejection of Claims 1-5, 7, 8, 10-16, and 27-29 under 35 U.S.C. §103(a).

In support of the rejection, the Examiner argues that Higashi's composition having up to 10wt% of the rare earth elements is close enough to the claimed composition having greater than 10wt% of rare earth elements that one of ordinary skill in the art would have expected these ranges to have the same properties. The Examiner relies on *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Respectfully, Appellant disagrees with the Examiner's conclusion and reliance on *Titanium Metals Corp.* because Higashi teaches away from using an amount greater than 10wt%. In *Titanium Metals*, there was no evidence establishing that the close ranges were not equivalent. In absence of such evidence, the court concluded that the ranges were equal. In contrast, Higashi teaches away from using an amount of rare earth element that is greater than 10wt% (col. 2, lines 46-47). Thus, the *Titanium Metals Corp.* case does not apply and one of ordinary skill in the art would not modify the composition of Higashi against the instructions of Higashi to include more than 10wt% of the rare earth element as claimed. For this reason, Appellant respectfully requests that the rejection be withdrawn.

III. Rejection of Claims 1-3, 7-12, 15, 16, 26, and 27 under 103(a).

In support of the rejection, the Examiner argues that the claimed minor alloy elements are inherent as impurities in the composition of EP570911. In further support, the Examiner points to "Aluminum and Aluminum Alloys," page 639, which lists various elements that are commonly found as impurities in aluminum alloys. Respectfully, Appellant disagrees with the rejection

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because the claimed elements are not impurities. That is, the claims recite "at least one minor alloy element" in the claimed composition. The term "minor alloy element" implies that the element is intended to be present within the composition in an amount suitable to contribute to the properties of the alloy. Thus, the claimed minor alloy element should not be interpreted as an impurity element, which is not intended to be present within the composition in any appreciable amount that affects the properties of the alloy. By interpreting the claimed minor alloy element as an impurity element, the Examiner has effectively and improperly read this limitation out of the claim. For this reason, Appellant respectfully requests that the rejection be withdrawn.

IV. Rejection of claims 1-6, 10-14, and 26-29 under 103(a).

On two occasions (May 15, 2007 and November 7, 2007), Appellant filed the Declaration Under CFR 1.131 to establish invention prior to the effective date of the Olson reference. In the first instance, the Examiner did not accept the Declaration on the basis that the Declaration was missing several formalities. Appellant then corrected these formalities, which did not relate to the substance of the Declaration, and resubmitted the Declaration at the later date. However, in the Advisory Action mailed on November 20, 2007, the Examiner indicated that the Declaration would not be entered because it was not earlier presented. Respectfully, Appellant contends that the Declaration was earlier submitted and the later filing of the Declaration was merely to correct the formalities. For this reason, Appellant respectfully requests that the Declaration be entered and considered relative to the subject rejection.

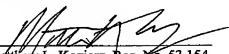
Closing

For the above reasons, the rejection of the claims should be reversed.

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Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,


Matthew L. Koziarz, Reg. No. 53,154
Carlson, Gaskey & Olds
400 W. Maple Road, Ste. 350
Birmingham, MI 48009
(248) 988-8360Dated: December 10, 2007

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Laura Combs